

REMARKS

Claims 1-28 are all the claims pending in the application. Claims 7-22 have been withdrawn by the Examiner as being drawn to a non-elected invention. New claims 25-28 have been added to further define the invention. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1-6, 23, and 24, under §103(a) as being unpatentable over JP 2000-63802 to Yasushi (hereinafter Yasushi). Applicants respectfully traverse this rejection because Yasushi fails to teach or suggest all the elements as set forth in the claims.

Claim 1 sets forth a method of making a paper body comprising the step of feeding a raw material with a predetermined concentration into water which is in a stirred condition. Thus, the water is in a stirred condition, and the raw material is fed into the stirred water. See, for example, page 8, 2nd full paragraph.

First, Yasushi fails to teach or suggest feeding the raw material from supply tanks 40a-c into water that is in a stirred condition in lauter tub 30. In contrast to that in claim 1, Yasushi discloses stirring a raw material and then passing it into a lauter tub 30. That is, Yasushi discloses that stirring supply tubs 40a-c contain the raw material. The raw material is then fed through connecting tubes 60 to funnels 38a-c, and into the lauter tub 30. However, Yasushi fails to teach or suggest that there is any water at all in lauter tub 30, let alone that it is in a stirred condition. Accordingly, Yasushi fails to disclose feeding a raw material with a predetermined concentration into water which is in a stirred condition, as set forth in Applicants' claim 1.

Second, Yasushi fails to teach or suggest feeding raw material into tanks 40a-c, wherein those tanks contain water in a stirred condition. On this point, Yasushi is completely silent; he only mentions that raw material of different components is supplied in the stirring supply tubs 40a-c. See paragraph [0014]. The Examiner asserts that it would be obvious to dilute the pulp in

stirred water when dilution is desired or is necessary.¹ Even assuming that dilution is carried out in Yasushi's supply tubs 40a-c, there is no teaching or suggestion of how that dilution is carried out, let alone that raw material is fed into water that is in a stirred condition. It is just as likely that, in order to carry out dilution in Yasushi's apparatus, one of ordinary skill in the art would add water to the raw material already existing in the tubs 40a-c. Accordingly, Yasushi fails to teach or suggest feeding raw material into water that is in a stirred condition, as set forth in claim 1.

Third, the Examiner has failed to establish *prima facie* obviousness. Instead, the Examiner makes the bald assertion that diluting pulp in stirred water "would fall within the levels of ordinary skill in the art". However, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" is not sufficient to establish a *prima facie* case of obviousness without some objective reason to modify the teachings of the references.²

Further, because Yasushi provides no teaching regarding feeding the raw material into water that is in a stirred condition, the Examiner appears to be relying on basic knowledge, and to the extent that he is, this rejection is improper. That is, the deficiencies of the cited references cannot be remedied by the Examiner's general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. The Examiner cannot simply reach conclusions based on his own understanding or experience—or on his assessment of what would be basic knowledge or common sense. Rather, the Examiner must point to some concrete evidence in the record in support of these findings.³

Moreover, because Yasushi is silent as to how the raw material may be diluted, the Examiner impermissibly relies on a mere statement of obvious at the exact point where

¹ Office Action at page 2, item 3, 2nd paragraph, lines 5-7.

² *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

³ *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

Applicants allege a patentable distinction. This the Examiner cannot do. After all, an Examiner may not rely on a mere statement of obviousness at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. See *Ex parte Cady*, 148 U.S.P.Q. 162 (Bd. of App. 1965).

Accordingly, for at least any of the above reasons, Yasushi fails to render obvious claim 1. Likewise, this reference fails to render obvious dependent claims 2-6, 23, and 24.

Claim Rejections 35 U.S.C. § 102

The Examiner rejected claim 1 under §102(b) as being anticipated by the TAPPI Official Test Method T 205 om-81 entitled “Forming Handsheets for Physical Tests of Pulp” (hereinafter the TAPPI test). Applicants respectfully traverse this rejection because the TAPPI test fails to disclose every element as set forth in the claims.

Again, claim 1 sets forth a step of feeding a raw material with a predetermined concentration into water which is in a stirred condition.

The TAPPI test discloses half-filling a sheet machine with water, and then pouring a measured sample of well mixed dilute [pulp] stock into the sheet machine. See section 7.2.1. That is, the pulp sample is “well mixed”, but the water in the sheet machine is not described as being “in a stirred condition” when the pulp is poured therein. It is only after the pulp has been poured into the water in the half-filled sheet machine that stirring takes place, as set forth in section 7.2.2. Accordingly, the TAPPI test fails to disclose a step of feeding a raw material with a predetermined concentration into water which is in a stirred condition, as set forth in claim 1.

For at least the above reasons, claim 1 is not anticipated by the TAPPI test.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

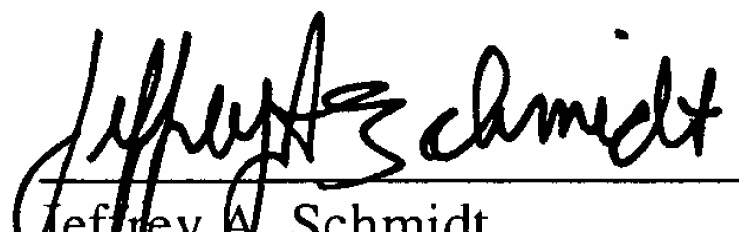
Amendment Under 37 C.F.R. § 1.111
U.S. Appln No. 09/899,601

Atty Dkt No. Q65349

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Jeffrey A. Schmidt
Registration No. 41,574

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 23 ,2004